REMARKS

The Non Final Office Action mailed December 27, 2007 has been reviewed and carefully considered. Reconsideration of the above-identified application, as herein amended and in view of the following remarks, is respectfully requested.

Claims 1-16 and 18-20 are pending in this application. Claims 1-2, 4-5, 9-13, 15-16 and 18 have been amended. Claim 17 has been cancelled without prejudice. No new matter has been added.

CLAIM OBJECTIONS

Claims 2, 4, 8, 9, 10 and 18 were objected to due to lack of antecedent basis. Applicant has amended claims 1-2, 4-5, 9-10, 12 and 18 have been amended to address the antecedent basis issues. Withdrawal of the objections is respectfully requested.

§101 REJECTIONS

Claims 15-20 were rejected as being directed to software per-se and thus do not constitute software subject matter. In response to the Examiner's comments, Applicant has amended claim 15 to delete, "e-mail software for providing e-mail capabilities to a user." Claims 16-20 depend from and include the limitations of claim 15.

Accordingly, withdrawal of the §101 rejection of claims 15-20 is respectfully requested.

-7-

§102 and 103 REJECTIONS

Claims 1, 6, 8, 15 and 20 were rejected under 35 U.S.C. §102(e) as being unpatentable over U.S. Patent No. 6,592,627 to Agrawal et al. (hereinafter "Agrawal").

Claim 9 was rejected under 35 U.S.C. 103(a) as being unpatentable over Agrawal.

Claims 2-5, 10-14 and 16-19 were rejected under 35 U.S.C. 103(a) as being unpatentable over Agrawal in view of US 6341306 to Rosenschein et al. (hereinafter Rosenschein).

Claim 7 was rejected under 35 U.S.C. 103(a) as being unpatentable over Agrawal in view of US 5999179 to Kekic et al. (hereinafter Kekic). Applicant respectfully disagrees with the rejections.

Claim 9 has been amended to recite, *inter alia*:

"selecting at least one of a show associations option and a hide associations option on a reply e-mail to be sent to a recipient; and
showing at least one of the discussion topic heading and associated e-mails of the reply e-mail to the recipient if the show associations option is selected."

Claim 15 has been amended to recite, inter alia:

"an associate feature for providing e-mail organization capabilities to the user by organizing e-mail messages to form at least one of an associated group of e-mails or an associated e-mail-to-topic group in at least one of the user's mailboxes, wherein the associated group of e-mails is formed by the user causing an options list to appear with respect to at least one first e-mail message, selecting an associate feature from said options list, and indicating a second e-mail, wherein the second e-mail is caused to be automatically associated to the at least one first e-mail to form the associated group of e-mails."

Agrawal is directed towards providing automation in defining and filling an organizational structure of document folders and involves a system for organizing document folders in response to classification indicia provided by a user. The user-selected document classification indicia includes at least one sample document representing a user-desired example of documents in a user-selected folder. One or more

-8-

folders are generated based on the user-defined document classification indicia, and incoming email documents are routed automatically into the one or more folders according the profile of each folder.

That is, Agrawal teaches a system for matching a document (an incoming email) to a profile of a folder automatically. One or more documents are moved into the folders based on their respective profiles. Each profile is determined based on a sample document which represents a user-desired example of the type of document that folder should contain. An incoming email is matched to a folder based having the highest probability of matching content.

First, the entire scheme of Agrawal is based on **automation** of the document organization. Agrawal provides a document management technique for organizing incoming emails automatically, based on the probability that they match a sample document in a predefined folder. That is, Agrawal's system is based on learning folder profiles based on sample documents and moves remaining documents into the folders accordingly. *See* Abstract, and Col. 2, lines 50-53, which recites: "[A]lso, the method includes automatically associating substantially all of the documents in the database with one or more folders, based on the sample documents."

Most significantly, in Agrawal, a **new folder must be created for each different topic**, and furthermore, in order for Agrawal's automated document association to occur, a sample document or rules representative of the desired classification indicia must then be put into the folder to represent its profile. *See* Col. 4, lines 51-60: "[A]s shown in block 50, the user can establish a tree-like hierarchy of empty folders by conventional means... Moving to block 52, the user inputs, for each folder, one or more classification

-9-

indicia in the form of sample documents. In addition, the user can define classification rules such as "send all emails from John to folder #3."

Such automation, and in fact Agrawal's entire automated association concept, completely teaches away from the present invention. Indeed, in stark contrast to Agrawal, the present invention advantageously provides a user-controlled e-mail organization technique which eliminates the need to create a new folder for each discussion topic. Thus, the user can associate emails which do not have the same sender or subject heading. The fact that the need to create a new folder for each new topic is eliminated is, indeed, a key focus of the present invention. *See* specification, page 2, lines 4-10.

There is no mention whatsoever in Agrawal of associating at least one first email with a second email by enabling an association option and forming an associated group of emails in the user mailbox comprising at least two or more associated emails, essentially as claimed in claim 1. Clearly, it is impossible in Agrawal for a user to manually associate two different emails to a common thread, since in Agrawal, documents such as incoming emails are sent to respective matching **folders**, as discussed above. *See* Col. 2 lines 45-47: "[I]n another aspect, a computer implemented method is disclosed for **organizing** semi-structured documents such as **email documents** in a database into **one or more folders**." (*emphasis added*.) Agrawal is completely silent with respect to any capability, need or desirability for associating an email directly to another email, as presently claimed in claim 1.

Furthermore, Agrawal fails to disclose or suggest at least an associate feature for providing e-mail organization capabilities to the user by organizing e-mail messages to

-10-

form at least one of an associated group of e-mails or an associated e-mail-to-topic group in at least one of the user's mailboxes, wherein the associated group of e-mails is formed by the user causing an options list to appear with respect to at least one first e-mail message, selecting an associate feature from said options list, and indicating a second e-mail, wherein the second e-mail is caused to be automatically associated to the at least one first e-mail to form the associated group of e-mails, essentially as claimed in claim 15.

Namely, Agrawal makes no mention of any ability nor capability of a user causing an options list to appear with respect to an email message. This is indeed not necessary or even desirable in Agrawal, since all emails are automatically organized into their respective folders by the computer system. In Agrawal, the user defines each folder into which documents are desired to be organized ahead of time, and email documents are later organized into folders which have the highest probability of a match. *See* Col. 5, lines 39-41: "[T]hen, for each available folder, the logic determines the probability that the document fits the folder in accordance with Naive Bayes classification principles, it being understood that the initial profile for each folder is established by the documents assigned to that folder by the user at block 52 in FIG. 3."

Finally, Agrawal fails to disclose or suggest at least selecting at least one of a show associations option and a hide associations option on a reply e-mail to be sent to a recipient; and showing at least one of the discussion topic heading and associated e-mails of the reply e-mail to the recipient if the show associations option is selected, essentially as claimed in claim 9. Applicant points out that the entire system and method of Agrawal is directed towards organizing documents on a user's personal computer only. There is

-11-

no mention whatsoever of any means for controlling display options on documents to be sent to another, much less determining whether information on an e-mail's associations may be shown to or hidden from a recipient of the email. Applicant notes that the Examiner points to Col. 7, lines 53-56 with regards to the show/hide associations options. However, this portion in Agrawal simply describes wherein a user may switch between viewing a normal inbox view and a folder-based view. Significantly, such a folder-based view is presented for display to the user only, as desired by the user. There is no disclosure or suggestion of the ability to select between a show or hide associations option on a reply email to be sent to a recipient, wherein if the show associations option is selected at least of a discussion topic heading and associated emails of the reply email is displayed to the recipient, essentially as claimed in claim 9.

Accordingly, it is respectfully asserted that independent Claims 1, 9 and 15 are patentably distinct and non-obvious over Agrawal for at least the reasons set forth above. Claims 2-8 depend from claim 1, claims 10-14 depend from claim 9, and claims 16 and 18-20 depends from claim 15. Claim 17 has been cancelled without prejudice. The dependent claims include the limitations of their respective independent claims and are therefore patentable and nonobvious for at least the reasons stated for claims 1, 9 and 15.

With respect to the §103 rejections, the rejection of claims 2-5, 7, 10-14 and 16-19 is based, in part, on the contention that Agrawal discloses or suggests the features of claims 1, 9 and 15, from which such claims respectively depend. However, in light of the above amendments and discussion, it is clear that the combination of Agrawal and/or Rosenschein and/or Kekic is legally deficient, since, at the very least, as explained above,

-12-

Agrawal does not disclose or suggest the features of claims 1, 9 and 15, from which

claims 2-5, 7, 10-14 and 16-19 depend.

It is therefore respectfully submitted that the present invention is not disclosed or

suggested by the cited references taken alone or in combination. Claims 1-16 and 18-20

are believed to be in condition for allowance for at least the reasons stated above. Early

and favorable reconsideration of the case is respectfully requested.

CONCLUSION

In view of the foregoing, Applicant respectfully requests that the rejections of the claims set forth in the Non Final Office Action of December 27, 2007 be withdrawn, that pending Claims 1-16 and 18-20 be allowed, and that the case proceed to early issuance of Letters Patent in due course.

It is believed that no additional fees or charges are currently due. However, in the event that any additional fees or charges are required at this time in connection with the application, they may be charged to applicant's representatives Deposit Account No. 07-0832.

Respectfully submitted,

Dated: 3/26/08

By: _____

Jeffrey D. Hale
Registration No. 40,012

Mailing Address:

Thomson Licensing Inc.
Patent Operations
P.O. Box 5312
Princeton, NJ 08543-5312